

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

442005-00105

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on _____

Signature _____

Typed or printed name _____

Application Number

10/606,498

Filed

6/26/2003

First Named Inventor

Clifford D. Bennett

Art Unit

3633

Examiner

Phi Dieu Tran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/David R. Jaglowski/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Signature

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Typed or printed name

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Registration number if acting under 37 CFR 1.34 _____

11/28/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Rejection of all pending claims over Hartzheim '949 in view of Moesta '029

Claims 1, 5-8, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029. Claims 4, 10-13, 17, 20-24, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029 and other additional references. All of the rejected claims require a chair "wherein each notch comprises a bearing surface defined by a lip extending inwardly from the outer surface such that the bearing surface is cantilevered beyond the inner surface." The Office admits that Hartzheim '949 does not disclose the claimed structure. However, the Office alleges that Moesta '029 discloses "the bearing surface of each notch defined by a lip (16) extending inwardly beyond the inner surface to provide for extra supporting surface for the tubular member (6)," and argues that it would have been obvious to modify the device of Hartzheim '949 "because it would provide more supporting surface for a tubular structure as taught by Moesta." Office Action mailed 6/28/2007 at p. 3. The Office rebuts the arguments submitted in the response filed April 20, 2007 and incorporated herein by reference by arguing that the grommet (6) in Moesta would be resting on two vertical edges (2 and 2'), and that when clamped together without the flange portion (16) "would have a large pressure on the member (6)." *Id.* at p. 11. The Office then conclusorily states that "the supporting surface thus provides more supporting surface for a tubular member to rest on [so that] modifying Hartzheim with Moesta [would] result in the tubular supporting surface area being larger." *Id.*

We respectfully argue that the Office's rejection under 35 U.S.C. § 103(a) is incomplete and therefore improper. "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex, Inc.*, slip op. at p. 14. Both *KSR* and Office policy require a finding that "design incentives and other market forces [would have] prompt[ed] variations of [the primary reference]." *See KSR*, slip op. at p. 13; 72 Federal Register 57526 at 57533. In addition, both require a finding that the disclosed technique would have been recognized as being capable of

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improving similar devices in the same way, e.g., by implementing a known variation or a simple substitution of a known element. *KSR*, slip op. at p. 13 and 72 Federal Register 57526 at 57533.

The asserted references are not directed to similar devices. The asserted secondary reference is directed to a clamp for tubes and pipes, Moesta '029, col. 1 ll. 3-4, whereas the claimed invention is directed to a notched chair for supporting rebar during the forming and pouring of concrete. The Office must therefore show, and not merely assume, that Moesta '029 is within the field of the Applicants' endeavor or otherwise reasonably pertinent to the particular problem at hand, MPEP § 2141.01(a)(I), so as to establish the required similarity. In view of the missing elements described below, it has not. Moreover, the Office must provide a reasoned basis such as a design incentive or market force *other than that disclosed in the Applicants' own filing* for its implicit assertion the provision of a cantilevered bearing surface in a rebar support chair would be desirable. It has not. In the absence of such evidence, the alleged case for obviousness is incomplete and the rejection improper.

Additionally, the allegedly obvious modification is not found in the properly ascertained differences between the prior art and the rejected claims, with the disclosed technique being used to improve the device in the primary reference *in the same way*. Hartzheim '949 admittedly does not disclose, teach, or suggest a rebar support chair having the claimed bearing surface configuration. Moesta '029 discloses a pipe clamp that may include a flange portion (16) that is provided for gripping a flexible and compressible grommet (6). Moesta '029, col. 2 l. 64 to col. 3 l. 65. However, the allegedly obvious modification does not even follow Moesta, but impermissibly omits both the opposing clamp member (2') and the grommet (6), negating an explicit teaching that these combined elements form an arrangement for preventing slip out of the clamp. The Office provides no substantial evidence to support its further modification of Moesta, and no explanation providing a reasoned basis for using elements found in a no-slip clamp in a claimed device that has no clamp function and does not act to prevent the slip of concrete reinforcement members positioned within the chair. Such is not a proper basis for an alleged case of obviousness, but a mere recitation of elements that were independently known in

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the prior art so as to produce a hindsight-based reconstruction of the claimed invention.

Rejection of claims 4 and 19 over Hartzheim '949 in view of Moesta '029 and Evans '422

Claims 4 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hartzheim '949 in view of Moesta '029 and further in view of Evans '422. The Office admits that the modified device of Hartzheim '949 would not include pairs of notches being connected by a bridge therebetween, the bridge connecting the troughs of the notches. However, the Office alleges that Evans '422 discloses "a chair having notches connected by a bridge (46) therebetween, the bridge connecting the troughs of the notches," Office Action mailed 6/28/2007 at p. 3, and argues that it would have been obvious to further modify the device of Hartzheim '949 "because having bridges connecting troughs of notches would reinforce the notches against compression forces as taught by Evans." *Id.* at p. 4. The Office rebuts the arguments submitted in the response filed April 20, 2007 and incorporated herein by reference by arguing that the Applicants are concerned with locating a tubular member within a slot on a structural member, and that Evans is relied upon to teach notches connected by bridging members without regard to the clamping function. *Id.* at p. 12.

Again, the asserted references are not directed to similar devices. Both the asserted secondary and tertiary references are directed to clamps for tubes and pipes, Moesta '029, col. 1 ll. 3-4, and Evans '422, Abstract, whereas the claimed invention is directed to a notched chair for supporting rebar during the forming and pouring of concrete. The Office's reliance upon a facially unreasonable abstraction of both the claimed device and the asserted references is not sufficient to establish such similarity, and impermissibly alters the scope of the Applicants' claims, which do not reach all tubular members positioned within all structural members. Moreover, the Office must provide a reasoned basis such as a design incentive or market force *other than that disclosed in the Applicants' own filing* for its implicit assertion the provision of bridges connecting a cantilevered bearing surface in a rebar support chair would be desirable. It

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has not. In the absence of such evidence, the alleged case for obviousness is incomplete and the rejection improper.

Also again, the allegedly obvious modification is not found in the properly ascertained differences between the prior art and the rejected claims, with the disclosed technique being used to improve the device in the primary reference *in the same way*. Hartzheim '949 admittedly does not disclose, teach, or suggest a rebar support chair having the claimed bearing surfaces and bridges. Moesta '029 discloses a pipe clamp that may include a flange portion (16) that is provided for gripping a flexible and compressible grommet (6). Moesta '029, col. 2 l. 64 to col. 3 l. 65. Evans '422 discloses a clamping member that includes longitudinal ribs (40) and transverse bracing ribs (46) projecting from an inner surface of a base portion (24), Evans '422 at col. 2 ll. 55-66, but it is admitted that such ribs are provided to reinforce against "compression forces," Office Action mailed 6/28/2007 at p. 4. Such a rationale runs directly contrary to the allegedly obvious modification, which omits both the opposing clamping member 10', bolts 12, and nuts 14 that generate such compression forces in the Evans device. Moreover, the Evans '422 reference reinforces the countervailing teachings in Moesta '029, in that Evans also uses "sleeve members or grommets 18 of rubber or other elastomeric material" in a type of grommet lock. Evans '422, col. 2 ll. 18-20. Because the claimed device does not make use of such grommets, and does not clamp around either a concrete reinforcing member or a pipe, it is clear that the Office has not shown that the modifications are implementations of known variations or a simple substitution of a known element having an established function. The Office provides no substantial evidence to support its additional modifications to the disclosures of Moesta and Evans, and no explanation providing a reasoned basis for using elements found in no-slip clamps in a claimed device that has no clamp function and does not act to prevent the slip of concrete reinforcement members positioned within the chair. Such substantial differences run contrary to the showing the disclosed technique(s) would have been recognized as being capable of improving similar devices in the same way required by both KSR and Office policy.

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Conclusion

In view of the foregoing remarks, we respectfully submit that the claims are allowable over the art of record and pray for reversal of the present rejections. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,

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